

## **REMARKS**

Claims 16-40 are currently pending. Claims 1-15 were previously cancelled. 16-22, 31-34 and 36-38 are currently withdrawn as directed to a non-elected invention. Claims 23-26 are amended to invoke "means plus function" claim language as authorized by 35 U.S.C. § 112, paragraph 6. Claims 27, 28, and 39 are amended to provide proper antecedent basis. No new matter is added.

## **Restriction**

The Examiner has restricted between Group I (claims 16-22, 31-34, 37 and 38) and Group II (claims 23-30, 35 and 39-40). It is noted that claim 36 does not appear in either group. Since claim 36 depends from claim 19, it is assumed that the Examiner meant to include it in Group I.

Applicants have elected Group II with traverse. Since all of the claims have already been searched, and multiple office actions have been issued thereon, it is unclear how there can be an undue burden on the Examiner at this point in the prosecution. For a restriction to be proper, the inventions must be both independent or distinct AND there must be a serious search and examination burden if restriction were not required. Applicants submit there is no serious burden since search and examination of all claims have already been conducted. Simply because there is a new Examiner on this case, this does not necessitate that the Office start the search and examination all over again.

## **102 Rejections**

Claims 23-30, 35, 39 and 40 are rejected under 35 USC 102(b) as allegedly anticipated by U.S. Patent 5,744,027 to Connell et al. ("Connell").

With respect to claims 23 and 26, Connell fails to disclose a means for setting a dialysing fluid flow rate  $Q_{d_b}$  during a dialysis treatment such that at the end of the pre-set treatment period  $T_B$ , the at least one receiving unit is either empty or contains a pre-set residual volume of the at least one dialysing fluid concentrate. The Examiner has identified the receiving unit as the third concentrate supply 116, the means for providing water as water source 82, and the means for mixing as mixing chamber 120 in Connell. Although Connell discloses a UF/PROP system 516 that controls the dialysis flow rate, there is no disclosure that the system 516 adjusts the flow rate

so that the receiving unit is empty or contains a pre-set residual volume of the concentrate at the end of the treatment time. Although Connell may disclose that the equalizer chambers are emptied, there is no disclosure of the concentrate supply 116 being emptied of concentrate.

The Examiner states “[r]egarding the limitations reciting configured to language, the examiner considers these to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a structural different between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art” (Office Action, page 5). Claims 23 and 26 have been amended to recited means-plus-function language under 35 USC 112, 6<sup>th</sup> paragraph.

According to the MPEP, “the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim.” MPEP § 2182 (emphasis added). “Such a limitation cannot be met by an element in a reference that performs a different function.” RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1445 n. 5 (Fed. Cir. 1984) (emphasis added); see also Ishida Co., Ltd. v. Taylor, 221 F.3d 1310, 1316 (Fed. Cir. 2000) (literally meeting a means-plus-function clause “requires that the accused device perform a function identical to that identified in the means clause” (emphasis added)). Only “if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.” MPEP § 2182. According to the MPEP, the first step in making a prima facie case of equivalence is to determine if the prior art element performs the function specified in the claim. MPEP § 2183. Applicants submit that the Examiner has ignored the initial step of the analysis, as the device in Connell does not perform an identical function. Thus, Connell does not disclose all the limitations of independent claims 23 and 26, and all claims dependent therefrom.

**Conclusion**

The Office may charge any additional fees required, or credit any overpayments, to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

KENYON & KENYON LLP

Dated: May 24, 2010

/Jocelyn D. Ram/

Jocelyn D. Ram  
Reg. No. 54,898

KENYON & KENYON LLP  
1500 K Street, N.W. - Suite 700  
Washington, D.C. 20005-1257  
Tel: (202) 220-4200  
Fax: (202) 220-4201